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Remarks/arguments:

By the present amendment claims 1, 2, 16, and 20 have been amended. In addition, claims 12, 25, and 28 have been cancelled for the purposes of advancing the prosecution of this application.

In the office action the examiner objected to the claims because they were presented in single line spacing. The present amendment presents the claims in 1.5 line spacing.

The examiner next rejected claims 1-6, 9-12, 14, 16, 17, 20-22, 25, 26, and 28 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. In this regard, the examiner states that the claims "... contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Applicants disagree for the following reasons.

The examiner takes the position that "the specification as originally filed fails to adequately describe the subject matter of claims 1 and 20." The examiner notes that a "further interconnecting material is provided between the tooth stump and the base structure." The examiner is correct in this. However, the further interconnecting material is not part of the invention. As stated initially on page 1 "The present invention relates to a dental restoration and a method for producing the dental restoration." Such a restoration is typically placed on interconnecting material which is then placed on a tooth stump. The restoration does not include a portion of the human body to which it is attached, or the cement (interconnecting material) for holding it to the body. As the examiner is well aware it is improper to claim a human body, or even a portion of it. However, in order to clarify what is being claimed, claims 1 and 20 have been amended to specify that the base structure has inner and outer contours and is "adapted to be on a selected one of a tooth stump of a tooth of the dental patient, interconnecting material on the tooth stump, ..." In view of this addition to the claim, it is believed to adequately describe applicants invention. Accordingly, the examiner is respectfully requested to withdraw his rejection set forth in paragraph 5.

The examiner next states that the limitation of "one layer" and the limitation of "elastic" is not in the original disclosure. The examiners attention is directed to FIG 6 which clearly shows that the interconnecting material 26 is a single layer. In this regard, the examiners attention is directed to COOPER CAMERON CORPORATION v. KVAERNER OILFIELD PRODUCTS, INC., 291 F.3d 1317, wherein it is stated:

We agree with Cooper, however, that the district court erred in granting summary judgment that the asserted claims of the '119 patent are invalid for failure to meet the written description requirement. In Vas-Cath, we held that "under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112." 935 F.2d at 1565, 19 USPQ2d at 1118.

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Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed. Id. at 1566, 935 F.2d 1555, 19 USPQ2d at 1119. In Vas-Cath, we reversed the district court's grant of summary judgment of invalidity of claims to a double lumen catheter having a combination of features. In particular, we disagreed with the court's statement that one could not tell from the drawings what combination of the disclosed features constituted "the invention" because "[t]hat combination invention is what the [patent's] drawings show." Id. at 1565, 935 F.2d 1555, 19 USPQ2d at 1118. The court's concern with "what the invention is" was misplaced, we explained, because there is no "legally recognizable or protected 'essential' element, 'gist' or 'heart' of the invention in a combination patent." Id. (quoting Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U.S. 336, 345, 81 S.Ct. 599, 5 L.Ed.2d 592 (1961)).

Clearly, applicant is entitled to rely upon the drawings for support of claimed features. Furthermore, as can be seen from page 4, lines 22-26 of the text of this application, by having the interconnecting material elastic, "fatigue breaks in the over structure occur in a significantly less frequent manner, as the pressure peaks, which typically manifest themselves in the tooth protuberance flanks during mastication, are better captured and compensated by the inventive approach." Clearly there is support for elastic as well as the single layer. Perhaps the examiner is spending too much time on "what the invention is", rather than examining the claims before him. In that the disclosure clearly supports "an elastic single layer", the examiner should withdraw the rejection set forth in paragraph 6.

The examiner in paragraph 7 objects to phrases which indicate there is no firing. It is the examiner's position that there is no support for this. There is nothing in the text of this application which indicates that there is a firing. Furthermore, applicant has stated that his process eliminates a time consuming firing. Any firing is time consuming. However, it is submitted, that the recitation concerning firing is in the nature of a whereby clause. In that the examiner is clearly in error for objecting to this facet of the claims, the withdrawal of this grounds of rejection is respectfully requested.

In paragraph 10 the examiner objects to the phrase "includes" which appears in claim 2. This has been changed to "has", which is consistent with claim 1 which recites that the over structure has "...an inner contour and at least one pre-configured bite element (38) having a predetermined bite surface on an outer contour". It is respectfully submitted that this limitation only further limits the over structure, and is not an additional structural element as the examiner contends. Further definition of claimed structure in a "consisting of" claim is believed to be permissible. The Mars decision has been considered, but applicant does not see anything there which would prohibit adding a further limitation to an element of the claim. Claim 16 has been amended to improve its form. As presently amended claim 16 does not add any element, step, or ingredient not found in claim 1 from

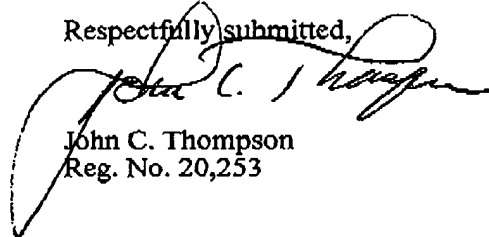
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which it depends, but merely limits a claimed element. As this is believed to be proper, the allowance of this claim is respectfully requested.

Finally, as noted above, claims 12, 25 and 28 have been cancelled. Therefore, the objections set forth in paragraphs 11 and 12 are moot. The allowability over the prior art, set forth in paragraphs 13-14 is noted.

In that all of the claims of this application are deemed to be in proper form the allowance of this application is respectfully requested.

Respectfully submitted,



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